

## **REMARKS**

### **I. Resubmission of Information Disclosure Statement**

Applicants resubmit copies of Third Supplemental Information Disclosure Statement and PTO Form 1449 that were previously filed on January 29, 2003. Applicants request that the Examiner review the referenced material and initial the PTO Form 1449. In addition, Applicant requests the Examiner to return the initialed copy of the PTO Form 1449.

### **II. Rejections to Claims 1-20**

Claims 1-9, 15-16 and 21-32 are pending in the application. Claim 1 stands rejected under 35 U.S.C. § 112 because the term, “the network” had insufficient antecedent basis. Claims 1, 2, 8 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,314,108 to Ramasubramani et al. (“Rama”). Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rama in view of U.S. Patent No. 6,047,051 to Ginzboorg et al. (“Ginzboorg”). Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rama in view of U.S. Patent No. 6,160,804 to Ahmed et al. (“Ahmed”). Applicants respectfully traverse the objection and rejections as follows.

#### **A. Rejection to Claim 1 under 35 U.S.C. § 112, First Paragraph**

Claim 1 stands rejected because the term, “network” had insufficient antecedent basis. Claim 1 has been amended to replace the term, “the network” with “a network.” Applicants submit that claim 1 as amended has sufficient antecedent basis. Thus, Applicants respectfully request the Examiner to withdraw the rejection to claim 1.

#### **B. Rejection to Claims 1, 2, 8 and 9 under 35 U.S.C. § 102(e)**

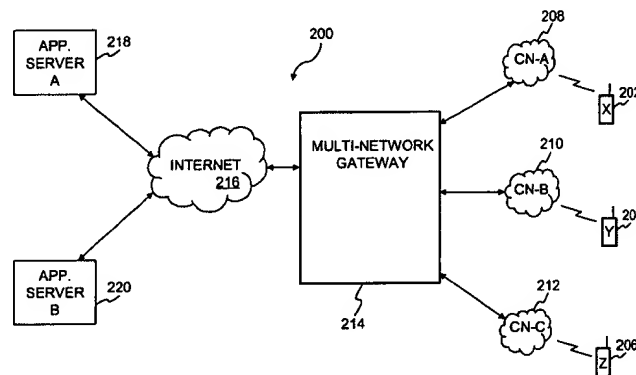
Claims 1, 2 and 8-9 are patentable at least because Rama does not disclose “wherein the server determines the available network-access measures for a location of the communication device and the communication device is configured to select at least one of the available network-access measures according to a task that the communication device performs.”

Claims 1-2 and 8-9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rama. The Office Action asserts that Rama discloses each and every element of claims 1, 2 and 8-9.

Claim 1 is directed to a communication system that utilizes a plurality of network-access measures. The communication system includes a communication device operable to connect a network using at least one of the plurality of network-access measures and a server operable to

connect to the communication device to provide the communication device with available network-access measures. In particular, claim 1 has been amended to include features, i.e., the server determines the available network-access measures for a location of the communication device and the communication device is configured to select at least one of the available network-access measures according to a task that the communication device performs.

Rama discloses a communication system that couples mobile communication devices to the Internet. In particular, Rama discloses a multi-network gateway 214 that couples many different wireless carrier networks 208, 210, 212 to the Internet 216 as shown in Fig. 2 below. Through the network gateway 214, the mobile communication devices 202, 204, 206 obtain information from servers 218, 220 located on the Internet 216.



**Fig. 2**

Fig. 2 of U.S. Patent No. 6,314,108 to Rama

Rama does not disclose that (1) the server determines the available network-access measures for a location of the communication device and that (2) the communication device is configured to select at least one of the available network-access measures according to a task that the communication device performs. In Rama, the network gateway 214 identifies each carrier network by using carrier name, network type, carrier transport identifier, etc. *See* Col. 7, lines 29-63. The servers 218, 220 merely provide data to the devices 202, 204 and 206 through the network gateway 214. The gateway 214 and the servers 218, 220 do not determine an available network-access measure for the location of the communication device. Further, the devices 202, 204 and 206 do not select available network-access measures according to a task that they perform. Accordingly, Rama does not provide advantages of the communication system defined in claim 1, i.e., as a communication device change locations, the communication device can switch to a new network-access measure selected from the available network-access measure

presented by the server, and the communication device can use the most cost efficient and reliable access measure for the tasks that the communication device performs.

Based on the above, Rama does not anticipate claim 1 because it does not disclose every element of claim 1. Claims 2, 8 and 9 depend from claim 1 plus additional features. Thus, Rama does not anticipate claims 2, 8 and 9. Accordingly, Applicants respectfully request the Examiner to withdraw the rejections to claims 1-2 and 8-9.

**C. Rejection to claims 3-5 under 35 U.S.C. § 103**

Claims 3-5 are patentable at least because neither Rama nor Ginzboorg teaches authentication key information and information device defined in claims 3-5.

Claims 3-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rama in view of Ginzboorg. The Office Action concedes that Rama fails to explicitly teach storing authentication-key information and informing the communication device of the authentication-key information defined in claims 3-5. However, the Office Action asserts that it would have been obvious for one of skill to modify Rama to provide keys to the communication devices in view of disclosure of Ginzboorg for the purpose of authorizing certain terminals for network access.

Claim 3 recites that the database of the server stores an authentication key information. Claim 4 recites that the server collects the authentication key information from a service provider. Claim 5 recites that the informing device informs the communication device of the authentication-key information.

Ginzboorg discloses a method of charging in a telecommunications system. The telecommunications system includes customer terminals used by customers for ordering services and servers for providing services to customers. If the customer terminals are cable TV network terminals, a billing server gives the customer terminals the first key, which it has received from the server providing service. *See* Col. 14, lines 45-49. The billing server asks customers for a payment by sending the key. Sending the first key can act as a proposal for an on-line contract from the side of the system. *See* Col. 14, lines 50-67.

Even if Rama may be combined with Ginzboorg, such combination does not disclose the communication system defined in claims 3-5. Claims 3-5 depend from claim 1 plus additional feature. As stated in Section II. B above, Rama does not disclose the recited server of claim 1. Nor does Ginzboorg disclose the recited server. Further, Rama as modified by Ginzboorg does

not disclose the communication system defined in claims 3-5. Rather, Rama modified by Ginzboorg discloses that the servers 216, 220 send devices 202, 204, 206 the key to ask for a payment through the gateway 214.

In addition, there is no motivation to combine Rama with Ginzboorg. Applicants respectfully submit that “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2142 at 2100-124. Rama discloses the multi-network gateway that couples many different wireless carrier networks to the Internet. On the other hand, Ginzboorg discloses that the billing server sends customers the key to ask for a payment of service. Accordingly, no teaching or suggestion is found in Rama and Ginzboorg to combine them to make the recited communication system of claims 3-5.

Based on the above, Rama and Ginzboorg do not teach or suggest claims 3-5, either individually or in combination. Applicants respectfully request the Examiner to withdraw the rejection to claims 3-5.

**D. Rejection to claims 6 and 7 under 35 U.S.C. § 103**

Claims 6 and 7 are patentable at least because none of Rama and Ahmed discloses that the server comprises an update mechanism to update information regarding available network-access measures when the communication device change its location; and an informing device for informing the communication device of the updated available network-access measure.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Rama in view of Ahmed. The Office Action concedes that Rama fails to explicitly teach an update mechanism defined in claims 6 and 7. However, the Office Action asserts that it would have been obvious for one of skill to modify Rama by updating network information whenever a mobile station changes location for the purpose of mobility management, as disclosed in Ahmed.

Claim 6 indirectly depends from claim 1 and claim 7 directly depends from claim 1. Claims 6 and 7 define a communication system having an update mechanism to update information regarding available network-access measures and an information device for informing the communication device of the updated available network-access measure information.

Ahmed discloses mobile communications systems 100 having mobiles 102 and network nodes 104. The mobile communications systems 100 have location management techniques that

operates as follows. Home Location Registers (“HLRs”) are used to track the locations of individual mobiles. A plurality of HLRs exists in the system 100 and certain network nodes may include HLRs. HLRs maintain the location of a mobile only through the network node it is currently attached to, i.e., the direct network node. If a mobile moves to another network node, it sends a location update message to its HLR.

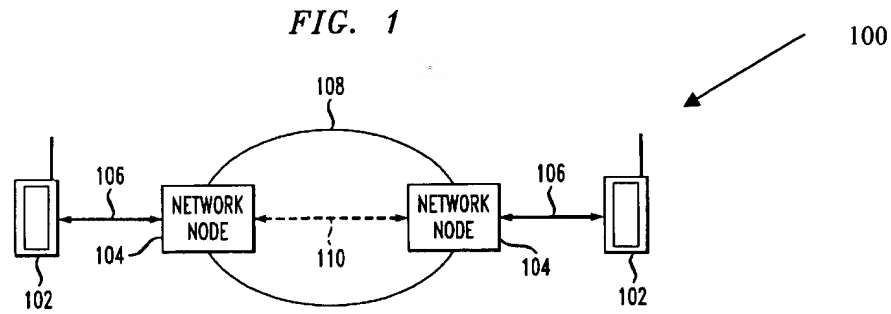


Fig. 1 of U.S. Pat. No. 6,160,804

Applicants submit that there is no motivation to modify Rama with the teaching of Ahmed. Rama discloses the multi-network gateway that couples many different wireless carrier networks to the Internet. On the other hand, Ahmed discloses connection between a mobile terminal and a network node. No teaching or suggestion is found in Rama and Ahmed to combine Rama’s system with location management technique of Ahmed. Further, neither Rama nor Ahmed discloses as to how Rama may be reasonably successfully combined with location management technique of Ahmed.

Even if Rama may be combined with Ahmed, such combination does not disclose the recited communication system of claims 6 and 7. Claims 6 and 7 depend from claim 1 directly and indirectly. As previously stated in Section II. B above, Rama does not disclose the recited server of claim 1. Nor does Ahmed disclose the recited server. Further, none of Rama and Ahmed discloses that the server comprises the recited update mechanism and information device of claims 6 and 7.

Based on the above, Rama and Ahmed do not teach or suggest claims 6 and 7, either individually or in combination. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection to claims 6 and 7.

#### **E. Rejection to claims 10-20**

The Office Action rejected claims 10-20 because “[c]laims 10-20 do not teach or define any new limitations above the rejected claims 1-9.” *See* the Office Action, p. 5, paragraph 12. The Office Action does not provide specific ground for rejection as to claims 10-20 except “for similar reasons” to those of the rejected claims 1-9. *Id.*

According to Manual of Patent Examining Procedure (“MPEP”), improperly expressed rejections are:

An omnibus rejection of the claim “on the references and for the reasons of record” is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground. A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.<sup>1</sup>

The Office Action fails to specify statutory grounds of rejections and cited reference(s) supporting such rejections as to claims 10-20. Applicants must guess how claims 10-20 were rejected. Applicants submit that the rejections to claims 10-20 were improperly expressed.

Nevertheless, none of the references alone or in combination teaches or suggests claims 10-20. Claims 10-14 and 17-20 have been cancelled and claims 15-16 have been amended to depend from claim 1 directly and indirectly. As discussed in Section II. B-D above, Rama, Ginzboorg and Ahmed do not teach or suggest claim 1 either alone or in combination. Because claims 15-16 depend from claim 1, Rama, Ginzboorg and Ahmed do not teach or suggest claims 15-16. Based on the above, claims 15-16 are patentable in view of Rama, Ginzboorg and Ahmed either under 35 U.S.C. § 102 (e) or 35 U.S.C. § 103(a). Applicants respectfully request the Examiner to withdraw the rejection to claims 15-16.

### **III. New Claims**

Claims 21-32 are newly added and support for these claims may be found in page 3, lines 4-22; page 5, line 8 to page 6, line 12; page 6, line 20 to page 7, line 8 and page 9, lines 3-8. Thus, no new matter is added.

Claims 21-32 are patentable for at least the reasons that they recite the feature that “the communication device connects to the server by using a default-access measure for query of the available network-access measures at the server and the communication device is configured to

---

<sup>1</sup> See MPEP § 707.07(d) at 700-118.

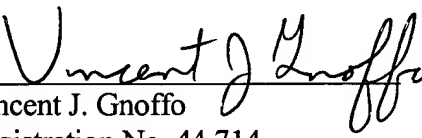
select at least one of the available network-access measures according to required networking qualities.” None of the cited references, either alone or in combination, discloses such a feature.

Thus, for at least these reasons, claims 21-32 are patentable and should be entered and allowed. Please note that new claims 21-32 are being presented to provide additional coverage for a method of generating a search result list and a method of displaying a search result list, and are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 535 U.S. 722 (2002).

### **CONCLUSION**

In view of the arguments above, pending Claims 1-9, 15-16 and 21-32 are patentable. Applicant respectfully requests the Examiner to grant early allowance of this application. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

  
\_\_\_\_\_  
Vincent J. Gnoffo  
Registration No. 44,714  
Attorney for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

**In the Drawing:**

As shown in the accompanying marked-up replacement sheet, please amend the drawing as follows.

Fig. 5 has been amended to correct a typographical error of “COMMUNICATIONS SOFTWARE DATABASE” to “COMMUNICATIONS SOFTWARE DATABASE,” which is identified by the numeral “520.”

The changes have been indicated in red and it is not believed to contain new matter.

Attachment: Replacement sheet





5/5

